

### **REMARKS**

Applicant appreciates the Examiner's thorough examination of the subject application and requests reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 1-23 are pending in the subject application.

Claims 5-8 are acknowledged as being allowable by the Examiner.

Claims 1, 9-18 and 23 stand rejected under 35 U.S.C. §102 and/ or 35 U.S.C. §103.

Claims 2-4 and 19-22 were objected to as depending from a rejected base claim, however, the Examiner indicated that these claims would be allowable if appropriately re-written in independent form.

Objected to claims 21 and 22 were canceled in the foregoing amendment and the limitations thereof were added to the related base claim, claims 9 and 10 respectively.

Claim 1 was amended to more clearly claim Applicant's invention.

Claim 2 was re-written in independent form as suggested by the Examiner.

Claim 20 was amended to correct a typo.

The amendments to the claims are supported by the originally filed disclosure.

### **35 U.S.C. §102 REJECTIONS**

The Examiner rejected claims 1, 9, 10 and 14 under 35 U.S.C. §102(e) as being anticipated by Tanishima [USP 6,597,533]. Applicant respectfully traverses as discussed below. Because claims were amended in the instant amendment, the following discussion refers to the language of

the amended claims. However, only those amended features specifically relied upon to distinguish the claimed invention from the cited prior art shall be considered as being made to overcome the cited reference.

As indicated in the above-referenced Office Action, claims 21 and 22 contain allowable subject matter and would be allowable if appropriately re-written in independent form. Claims 21 and 22 depend from claims 9 and 10 respectively. As indicated herein, claims 9 and 10 (*i.e.*, the base claims for claims 21 and 22) were amended so as to include the limitations of claims 21 and 22. As such, Applicant believes that claims 9 and 10 are in allowable condition at least for this reason.

As to claim 14, this claim depends from claim 10. Thus, it is respectfully submitted that claim 14 is allowable at least because of its dependency from a base claim that is believed to be allowable. The foregoing, however, should not be considered an acceptance by Applicant of the grounds on which claim 14 is being rejected or an admission that claim 14 is not itself separately patentable from the cited reference.

As to claim 1, this claim was amended to more clearly describe the configuration and/ or arrangement of the spring section with respect to the rotation support point. More particularly, the claim was amended to provide that the portion of the spring section that extends towards and past the rotation support point also is extending in a direction that corresponds to the direction of insertion of the disk cartridge. As is clear from the figures from Tanishima referred to in the above-referenced Office Action, the spring section in Tanishima is arranged so as to extend away in a direction that is opposite to the direction of insertion of the cartridge. As such, the structure and

arrangement of the spring section of the claimed invention is different from that described and taught in Tanishima. It also is submitted that there is no teaching or suggestion in Tanishima to orient the spring section so as to have the arrangement claimed by Applicant, and moreover there is no teaching that such an arrangement would be reasonably successful.

As the Federal Circuit has held, in deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify *corresponding elements* disclosed in the allegedly anticipating reference (emphasis added, citations in support omitted). *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F. 2d 1452, 221 USPQ 481,485 (Fed. Cir. 1984). In concluding that the '770 Patent did not anticipate the claims, the Federal Circuit in *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, at 221 USPQ 485-486, further provides that:

The '770 patent discloses an entirely different device, composed of parts distinct from those of the claimed invention, and operating in a different way to process different materials differently. Thus, there is no possible question of anticipation by equivalents. Citations omitted.

It is clear from the foregoing remarks that the allegedly corresponding elements in Tanishima do not in fact correspond to the elements or features of the claimed invention that the Office Action asserts correspond thereto. Thus, there can be no disclosure or teaching in Tanishima of Applicant's invention.

It is respectfully submitted that for the foregoing reasons, claims 1, 9, 10 and 14 are patentable over the cited reference and thus satisfy the requirements of 35 U.S.C. §102(e). As such, these claims, including the claims dependent therefrom are allowable.

### 35 U.S.C. §103 REJECTIONS

Claims 11-13 and 15-18 stand rejected under 35 U.S.C. §103 as being unpatentable over Tanishima [USP 6,597,533] as applied to claim 10 and further in view of Takahashi [USP 6,236,541]. Applicant respectfully traverses as discussed below. Because claims were amended in the instant amendment, the following discussion refers to the language of the amended claims. However, only those amended features specifically relied upon to distinguish the claimed invention from the cited prior art shall be considered as being made to overcome the cited reference.

In the foregoing remarks regarding claim 10, it is indicated that claim 10 was amended so as to include the limitations of canceled objected to claim 22 and further that such amendment placed claim 10 in a condition for allowance. As such and at least because of their dependency from an allowed base claim, each of claims 11-13 and 15-18 are patentable over the cited combination of references. The foregoing, however, should not be considered an acceptance by Applicant of the grounds on which claims 11-13 and 15-18 are being rejected or an admission that these claims are not separately patentable from the cited combination of references.

It is respectfully submitted that for the foregoing reasons, claims 1-13 and 15-18 are patentable over the cited reference(s) and satisfy the requirements of 35 U.S.C. §103. As such, these claims, including the claims dependent therefrom are allowable.

CLAIMS 2-4 & 19-22

In the above-referenced Office Action, claims 2-4 and 19-22 were objected to as being dependent upon a rejected base claim. It also was provided in the above-referenced Office Action, however, that these claims would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claim(s).

Claim 2 was re-written in the foregoing amendment so as to be in independent form and to include all the limitations of the base claim there being no intervening claim(s). As such, claim 2 is considered to be in allowable form.

As to claims 3-4 and 19-20, these claims were not re-written in independent form as suggested by the Examiner. Applicant however, reserves the right to later amend the subject application so as to present any one or more of these claims in independent form or to add one or more independent claims that contain the limitations any one or more of claims 3-4 or 19-20.

Claims 21-22 were not expressly re-written in independent form as suggested by the Examiner, rather each of claims 21 and 22 were canceled and the limitations thereof were added to the related base claim, claims 9 and 10 respectively. Accordingly, claims 9 and 10 as amended are considered to be in allowable form.


It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

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U.S.S.N. : 10/036,065  
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Because the total number of claims and/or the total number of independent claims post amendment now exceed the highest number previously paid for, a check is enclosed herewith for the required additional fees. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,  
Edwards & Angell, LLP

Date: January 19, 2005

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